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Dominique Chantrain

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3213

EXAMINER

BARQADLE, YASIN M

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/891,545  
Filing Date: June 27, 2001  
Appellant(s): CHANTRAIN ET AL.

**MAILED**

**JUL 13 2007**

**Technology Center 2100**

David J. Cushing  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 21, 2007  
appealing from the Office action mailed January 26, 2006.

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(8) Evidence Relied Upon**

Provino U.S. Patent Number (6557037).

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Provino U.S. Patent Number (6557037).

As per claim 1, 8-12, Provino teaches a method for enabling a user registered in an Network Access Server as already connected to a host Virtual Private Network (authorized users 12m'=m connected VPN 15 via ISP 11) to communicate with at least one communication device outside of said host Virtual Private Network (communicate devices 13 or arrows 16 "TO/FROM OTHER ISP'S col. 5, lines 43 to col. 6, line 28 and col. 13, lines 26-53), said Network Access Server having access over a data communication network (internet 14) to said communication device and to a plurality of Virtual Private Networks including said host Virtual Private Network (network 15 and other private networks connected to internet 14, fig. 1 col. 6, 43-65), where said method comprises;

detecting a message being sent from said user and to said communication device while said user is currently connected to said host Virtual Private Network (receiving a message destined to devices in the private network by firewall 30 via the secure tunnel col. 5, lines 43-65. See also col. 12, lines 1-40 and col. 9, lines 46 to col. 10, line 33);

directing said message to a logical channel between said

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Network Access Server and said communication device (see logical channel 41-44 fig. 1; col. 3, lines 38-46 and col. 4, lines 23-65 and col. 9, lines 46 to col. 10, line 33), wherein said logical channel has, as a logical identifier, an identifier of said host Virtual Private Network to which said user currently connected (secure channel (40,42 and 44) is established between device 12(m) and device within VPN network 15 (col. 9, lines 6-65 and col. 15, lines 21-65). The transferred message packet contains header portion that identifies the source and destination address. Because authorized external devices connect the VPN network via a logical channel as shown in fig. 1, it is inherent that the established connection of device 12(m) uses an identified and recognized/approved logical connection (via tunneling protocol) (col. 3, line 59 to col. 4, lines 14 and col. 5, lines 43-65. see also col. 12, lines 1-40).

As per claim 2-3, Provino teaches the invention comprising:

detecting a message from said communication device being received at said Network Access Server on the logical channel having, as logical channel identifier, the identifier of a Virtual Private Network, said message containing a user destination address (The transferred message packet contains header portion that identifies the source and destination

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address col. 3, line 59 to col. 4, lines 14 and col. 5, lines 43-65. see also col. 9, lines 46 to col. 10, line 33 and col. 12, lines 1-40); determining a user registered in said Network Access Server as already connected to said Virtual Private Network and corresponding to said destination address (authorized user access the VPN network col. 9, lines 46-65); and forwarding said message from said Network Access Server to said user (col. 5, lines 1-59).

As per claim 4, Provino teaches the method according to claim 1, wherein said messages belonging to the communication between said user and said communication device are encapsulated in data packets, said data packets comprising a field containing said identifier of said host Virtual Private Network or an indication derived of said identifier (col. 3, lines 1-9 and col. 5, lines 1-59).

As per claim 5, Provino teaches the method according to claim 4, wherein said messages belonging to the communication between said user and said communication device are sent over a tunnel, wherein said tunnel has, as a tunnel identifier, said identifier of said host Virtual Private Network as tunnel identifier (to establish a secure tunnel one must use identifiers of the

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connected entities fig. 1 and col. 5, lines 43-59; col. 12, lines 1-40 and col. 9, lines 46 to col. 10, line 33).

As per claim 6, Provino teaches the method according to claim 1, wherein said messages contain IP packets comprising an IP address of said user (col. 3, lines 62 to col. 4, line 14).

As per claim 7, Provino teaches the method according to claim 1, wherein said communication device is a server belonging to a Virtual Private Network, called local Virtual Private Network, associated to said Network Access Server and different from said host Virtual Private Network (col. 9, 6-45 and col. 11, lines 46 to col. 12, line 16).

As per claim 13, Provino teaches forwarding engine that forwards message from logical controller to said user after user has been identified (col. 9, lines 32-65).

#### **(10) Response to Argument**

In response to Appellant's statement (page 11, first paragraph) "The central concept of the present invention is that a Network Access Server (NAS) 131 in Fig. 1 serving plural users 111 and 112 each connected to a different VPN (e.g., 152 and 153 in Fig.



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1), may assign the same IP address to each of the users, and when the NAS 131 sends a message from a user to a destination outside of the VPN to which that user is connected, it can continue to use the IP address of the sender as the return address, but it can set up a logical channel that is uniquely associated with the VPN to which the sender is connected. At the receive end, the logical channel identifier of the logical channel may have no particular significance. But when the receive end sends a reply to the IP address indicated as the source of the original message, it will be directed back on the same logical channel to NAS 131, and NAS 131 will be able to uniquely identify the user 111 from the combination of the IP address and the VPN associated with the logical channel."

Examiner notes that the main features in the above statement are not recited in the claims. For example, the feature of assigning " the same IP address to each of the users, and when the NAS 131 sends a message from a user to a destination outside of the VPN to which that user is connected, it can continue to use the IP address of the sender as the return address, ..." and "... when the receive end sends a reply to the IP address indicated as the source of the original message, it will be directed back on the same logical channel to NAS 131, and NAS 131 will be able to

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uniquely identify the user 111 from the combination of the IP address and the VPN associated with the logical channel." are not recited in the claims.

Examiner notes the preamble of claim 1 recites an intended use feature such as a method for enabling a user registered in a Network Access Server as already connected to host VPN to communicate with a device outside of a host VPN. Similarly, Provino's invention enables a VPN connected devices to access other devices outside the VPN network as shown in fig. 1 (see outside device connected to arrows 16 "TO/FROM OTHER ISP'S" and external device 13. See also the rejection below).

In page 11 last paragraph to page 12 first paragraph and page 13, it appears that the applicant is arguing that Provino does not teach a user connected to the VPN 15 does not also connect to an outside device. However, the Appellant recognizes that Provino's device to 12(m) communicates with external devices along paths 16 "TO/FROM ACCESSED DEVICES" in Fig. 1 (see page 12, first paragraph where the Appellant states. "For purposes of this appeal it can be accepted that there will be an occasion on which one of the users 12(m) will communicate with a device

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along the paths labeled as "TO/FROM ACCESSED DEVICES" in Fig.

1."

The Appellant continues to argue in page 12, first paragraph "But in order for there to be anticipation, there must be a teaching in Provino that such a user is maintaining its connection to the VPN 15 while at the same time communicating with one of these other devices. There is no such discussion in Provino."

Examiner notes that Appellant's statement in page 11 last paragraph that " Provino teaches a plurality of users (12(1) to 12(M)) served by a network access server (ISP 11), and discusses how one of these users 12(m) can communicate with a device within VPN 15 by sending to the firewall 30 a network address request message, the firewall 30 forwards the request to a name server 32, the name server replies to the firewall with the network address, and the firewall 30 returns this network address to the user 12(m) for use in subsequent communications..." is a correct statement. However, the Appellant missed the point that the returned network address to the user 12(m) also corresponds to the human-readable Internet address for device 13 external to the VPN 15. (See col. 13, lines 46-53 and col. 14, lines 27-56).

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In summary, Provino's invention is very similar to Appellant's invention in so many ways:

A- device 12(m) connects to servers 31 and 32 located in VPN 15 via tunnel/logical connections 40, 42 and 44 over Internet 14 (see fig. 1 devices 12(1) to 12(m), VPN 15 and device 13).

B- device 12(m) sends a service request to access device 13 (external to VPN 15 see fig. 1). The request is detected and forwarded to Name servers 17 or VPN name server 32. An IP address is returned corresponding to a requested human-readable address of device 13 (see col. 13, lines 2-67). Once the communication is established between device 12(m) and device 13 or any external devices connected to outside ISP through arrows 16 of fig. 1, a logical identifiers such 41-44 take the message to the particular requesting device 12(1) to 12(m) depending on destination and source address as identified by the TCP/IP header information (see col. 5, lines 43-65; col. 6, lines 51 to col. 7, line 21 and col. 9, lines 6-65).

A relevant example to Provino and Appellant's invention is a typical USPTO employee with a government laptop configured to access the Patent Office from his home via a VPN or a sales person with a corporate laptop connecting to his headquarters

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via VPN connection. During the VPN connection with the Patent Office the employee is authenticated and messages are exchanged via secure tunnel (logical connection). At the same time while the employee or the sales person is connected to the company or (USPTO), the employee or the sales person can also connect to an outside computer via the Internet such as google website (www.google.com) or Yahoo website (for example by making a query or search). The results of the query are returned to the user from the outside network such as Yaahoo.com or google.com server to the user via an identified channel depending on the Internet Service Provider of the user in combination of the already VPN connection with the headquarters.

The Appellant also argues "there is also the problem that even in the secure tunnel communications there is no suggestion that the ISP 11, which the examiner equates with the claimed network access server, will establish a logical channel to such other external device, and will use a logical channel identifier an identifier of the VPN 15." Examiner respectfully disagrees. For example, Provino shows logical channel between device 12(m), ISP 11, Internet 14, arrows 16 "TO/FROM OTHER ISP'S" and VPN 15, "Communications between devices external to the virtual private network 15, such as device 12(m), and a device, such as a server

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31(s), inside the virtual private network 15, may be maintained over a secure tunnel between the firewall 30 and the external device as described above to maintain the information transferred there between secret while being transferred over the Internet 14 and through the ISP 11. A secure tunnel between device 12(m) and virtual private network 15 is represented in FIG. 1 by logical connections identified by reference numerals 40, 42, and 44; it will be appreciated that the logical connection 42 comprises one of the logical connections 41 between ISP 11 and Internet 14, and logical connection 44 comprises one of the logical connections 43 between the Internet 14 and the firewall 30." (Col. 9, lines 32-65; col. 5, lines 42-65 and col. 13, lines 22-67).

Independent claims 8-10 and 12 include essentially the same limitations (see page 13 second paragraph of the Appeal Brief). Therefore the same response to claim 1 above applies.


**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

YB 

Conferees:



LYNNE H BROWNE  
APPEAL PRACTICE SPECIALIST, TQAS  
TECHNOLOGY CENTER 2100



GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100